

A. Status of the Claims

Claims 1-31 were filed with the original application and pending at the time of the Action. No amendments have been made herein. Claims 1-31 are therefore presented herein for reconsideration. A clean copy of the pending claims is provided in Appendix A.

B. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Action maintains the rejections of claims 3, 4, 14 and 21 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out the subject matter which Applicant regards as the invention.

With regard to the rejection of claims 3, 4 and 14, Applicants submit that the claims are not indefinite as set forth in the previous Response to Office Action, which is herein incorporated by reference.

With regard to claim 21, it is noted that the claim reads as follows:

21. A process of producing corn seed, comprising crossing a first parent corn plant with a second parent corn plant, wherein one or both of the first or the second parent corn plant is a plant of the corn variety I026458, wherein a sample of the seed of the corn variety I026458 was deposited under ATCC Accession No. PTA-3228, wherein seed is allowed to form.

The Action appears to have two objections to the claim: (1) that it uses the term “comprising” and thus could allegedly include other steps, and (2) that claim 22 further defines the method of claim 21 as a process of producing F1 hybrid corn seed and thus claim 21 could include other steps.

With regard to the first issue, it is noted by Applicants that the rejection applies to any use of open language, because certain steps could allegedly be added to any claim in which the transition “comprising” is used. That is, anytime “comprising” is the transition, as it is in the

overwhelming majority of claims issued by the USPTO, other steps could be envisioned. For example, a claim to a composition comprising components A and B would be infringed by a composition containing A and B but to which any number of other, unspecified components had been added. Similarly, a claim to a method comprising steps A and B would be infringed by a process involving steps A and B, regardless of whether steps C and D were later carried out. However, what is relevant under 35 U.S.C. §112, second paragraph, is that one of skill in the art be able to understand the metes and bounds of what is claimed. The steps in the instantly claimed process of producing corn seed have been fully recited and thus the metes and bounds of the claim are fully set forth. It has not been alleged that any essential steps are missing or that any of the steps listed are incomplete. All of the steps are recited and clear. The claim is thus fully definite.

With regard to the second issue, it is noted that claim 21 is not limited to crossing corn plant I026458 with itself. The claim is written in alternative form to include the situation where both parent plants are of corn variety I026458, as well as where one of the parents is a plant other than corn variety I026458. Claim 22 narrows this by specifying the situation to where only one parent corn plant is I026458. The claim is therefore fully definite and the addition of the limitation of “F1” before “corn seed” would be inconsistent with the language of the claim.

In view of the foregoing, removal of the rejections under 35 U.S.C. §112, first paragraph is respectfully requested.

C. Rejection of Claims Under 35 U.S.C. §112, First Paragraph – Written Description

The Action rejects claims 3, 4, 14, 21 and 24-31 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as

to convey that Applicants were in possession of the claimed invention. Applicants respectfully traverse.

With regard to the rejection of claims 3, 4, 14, and 24-30, Applicants submit that the claims do not lack written description for the reasons submitted in the previous Response to Office Action, which are incorporated herein by reference.

With regard to claim 31, Applicants respectfully request that the Office set forth the legal basis for the rejection. Applicants understand from a telephonic interview held in serial number 09/788,334, which has claims that are substantially identical and has received a substantially identical office action as the instant case, that it is the position of the Office that written description must be provided for each intermediate product in a method claim in the same manner as if the particular product was individually claimed as a composition of matter. That is, Applicants understand that the position taken is that it is not sufficient to describe all of the starting materials for a process and all of the steps carried out on the starting materials, but rather that the structural characteristics of any product made at any intermediate step must be described as if claimed as compositions of matter. However, Applicants respectfully disagree with this legal contention and ask that the position and legal basis therefor be set forth with citation to the relevant legal authorities, as this has not been described in an office action. Such an explanation is necessary so that Applicants may adequately and fully respond to the rejection.

As set forth in the USPTO Written Description Guidelines, a description as filed is presumed to have an adequate written description and the Examiner must present a preponderance of evidence to the contrary to maintain a written description rejection. 66 Fed. Reg. 1099, 1107; citing *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971) and *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). The basis has not been provided for the rejection of claim 31.

Applicants therefore respectfully request that the rejection and legal authority on which it is made be explained on the record.

With regard to claim 21, Applicants also request that the basis of the rejection be explained on the record so that an adequate response may be made. Again, claim 21 reads as follows:

21. A process of producing corn seed, comprising crossing a first parent corn plant with a second parent corn plant, wherein one or both of the first or the second parent corn plant is a plant of the corn variety I026458, wherein a sample of the seed of the corn variety I026458 was deposited under ATCC Accession No. PTA-3228, wherein seed is allowed to form.

Therefore, all that the claim requires is crossing a plant of the corn variety I026458 with itself, including another plant of variety I026458, or any second variety. The latter option is specified in claim 22, but is not required in claim 21 given that the claim is drafted in the alternative. In claim 21 either one or both of the parent plants may be from the corn variety I026458. It has not been alleged that corn variety I026458 is not fully described, thus it is assumed that the rejection is made with regard to crossing variety I026458 to a second plant as required in claim 22. However, claim 22 has not been rejected. The basis for the rejection is thus not understood. Applicants therefore respectfully request that the rejection and legal authority on which it is based be explained on the record so that a full response thereto may be made.

D. Conclusion

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.